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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,633	10/09/2001	Stephen L. Palmer	SIERRA #7	1024
7590	03/30/2004		EXAMINER	
THOMAS R. LAMPE			WEINSTEIN, STEVEN L	
Bielen, Lampe & Thoeming			ART UNIT	PAPER NUMBER
Suite 720			1761	
1990 N California Blvd.				
Walnut Creek, CA 94596				
DATE MAILED: 03/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/974,633	PALMER ET AL.	
	Examiner	Art Unit	<i>ed</i>
	Steven L. Weinstein	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 20 November 2003.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1,3,5,6 and 8-11 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3,5,6, and 8-11 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4)  Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,5,6, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naor et al ('374) in view of Kiryu (Jp '118), Sailor Pen (Germ. '391), Shion Kagaku (Jp '020), Pentel (Jp '837), Pentel (Jp '600), Nable (Germ '800) and Wagner Pelikan (Germ '906) or Kiryu, Sailor Pen, Shion Kagaku, the two Pentel references, Nable and Wagner Pelikan, in view of Naor et al, both combinations further in view of Williamson ('143), essentially for the reasons clearly and fully detailed in the Office action mailed 5/22/03.

Claims 1 now adds some additional language which adds relative phrases and functional recitations of properties. For example, the flexible nib is recited as being "highly" flexible. How flexible is " highly " flexible is not clear. As noted previously, Noar et al discloses an apparatus for decorating an edible food comprising a hand held container containing edible liquid decorating food substance and a nib for transferring the liquid substance to foods as one would use a marker and wherein the foods can be soft foods and can even be frosting or icing. Thus, Naor et al teaches a device which has applicant's intended function. Claim 1 now recites that the flexible nib is an open cell foam material, which was previously recited in claim 2. The nib of Naor et al, which is to be used in applicants' disclosed and claimed environment, is disclosed as being fibrous. As noted previously, the art taken as a whole teaches that applicants are not the first to employ resilient, flexible nibs for transferring liquid colorant in a marker pen. Since Naor et al. discloses using his marker on delicate, soft surfaces without damaging the soft surface,

including even whipped cream and frosting, to modify Naor et al and substitute conventional open celled, resilient foam nibs for those of Naor et al, especially when the art taken as a whole already teaches employing open cell resilient foam to transfer liquid decorating substance to icing using such material would have been obvious. If, in fact, the nib of Naor et al did not possess the property recited at the bottom of page 2 of the amendment, (although this is not at all clear since Naor et al specifically discloses decorating soft foods without damaging the food), the art taken as a whole fairly teaches it would have been obvious to employ a conventional open cell foam, resilient nib marker which would possess the recited property. From the art taken as a whole, it is clear that applicant is not the inventor of the nib and its properties. At best, applicants have combined a conventional nib with a conventional marker containing liquid decorating substances. However, the art taken as a whole teaches this would have been obvious for the reasons given previously and above. The intended use and functional properties recited on page 3 of the amendment relative to capillary action, nib flexing laterally, liquid substance being transferred to the nib side wall, if not already inherently present as properties in the nib of Naor et al would be present in the combination of references taken as a whole employing Naor et al as the primary reference. That is, conventional, flexible bendable foam nibs such as Sailor Pen would inherently exhibit these properties.

All of applicants remarks filed 11/20/03 have been fully and carefully considered but are not found to be convincing for the reasons given above and below. It is noted that applicant's are urging limitations not found in the claims. The urgings put great emphasis on the fact that the device can write on wet and/or very soft surfaces such as frosting, but the claims are silent in regard to frosting. The claims only recite functional capabilities and properties of the device

relative to food “even when said edible food is soft”. Also, how soft is soft? That is, what does this term mean relative to the nature of the food. Marshmallows, for example, would be considered a soft food as would soft scrambled eggs, freshly baked cookies without icing that have not sat for too long, etc. Thus, properties are being linked to a phrasing which is much broader than the frosting applicants argue. On page 10 of the amendment, it is urged that Naor et al does not actually disclose structure which could perform in the manner disclosed. Naor et al, like applicants, disclose that the marker can be used on frosting surfaces without damage. Thus, Naor et al recognize the problem and has a solution. The claims now recite that the nib is elastic, “highly “ flexible open cell foam of “high” hydrophilicity, (the terms” highly” or high are also relative terms). Not only are these properties inherent in the conventional open cell foam flexible nibs, such material has been used to transfer ink to soft frosting surfaces (Williamson) to prevent damage. Contrary to what is urged on page 12 of the response, most open cell foams are not rigid but this is seen to be moot in view of the art taken as a whole teaching elastic, flexible resilient nibs as discussed above and previously. It is urged that Kiryu does not teach nib flexibility. “Hard wearing”, used by Kiryu, clearly refers to how well it lasts and not how hard or soft it is. In regard to applicants urging that Sailor Penn does not suggest using the nib for soft food, as discussed above and previously, Sailor Penn is relied on in combination and it is what the art taken as a whole teaches that is used to determine patentability. Note, too, the claims are directed to a device and not a method of using the device. The urgings treat the other references in the same manner; i.e. arguing each one separately, rather than addressing there use in the rejection taken as a whole.

Finally, it is urged that Williamson stamps instead of laterally remarks. This, of course, is an issue of intended use. However, the urging is also not convincing since stamping would potentially cause damage to a soft surface to the same degree or greater than a light movement across a surface. The fact is, Williamson teaches that if one is going to touch a surface of a soft food such as icing to transfer a liquid decoration or mark, one should use resilient, yielding foam.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be directed to Steven Weinstein whose telephone number is (571) 272-1410. The examiner can generally be reached on Monday-Friday 7:00am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (571) 272-1201.

S. Weinstein/af  
March 22, 2004

*Steve Weinstein*  
STEVE WEINSTEIN  
PRIMARY EXAMINER 1761  
3/25/04